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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Ted Eugene Wright
Application No. : 09/499,069
Filed : February 4, 2000
For : SINGLE-SHEET REGISTRATION FORM AND KEY PACKET

Examiner : Monica Smith Carter
Art Unit : 3722
Docket No. : 35008.001
Date : November 27, 2002

DECLARATION OF TED EUGENE WRIGHT

Sir:

I declare that I am the named inventor in the above-identified patent application. Submitted herewith are statements of fact and documentation that demonstrate that my SINGLE-SHEET REGISTRATION FORM AND KEY PACKET, as claimed in claims 1-7 and 11-15 of Continuation Prosecution Application No. 09/499,069, is non-obvious in light of the references cited by the Examiner, and arguments made by the Examiner, during prosecution of U.S. Patent Application No. 09/499,069 and the Continuation Prosecution Application.

1. I assigned my rights to the **SINGLE-SHEET REGISTRATION FORM AND KEY PACKET**, as claimed in claims 1-7 and 11-15 to Electronic Forms Plus, recorded June 22, 2000, at Reel/Frame: 010874/0719. Electronic Forms Plus, in turn, assigned its rights to Electronic Forms Plus, Inc., recorded March 16, 2001, at Reel/Frame: 011623/0634, which I am the owner.
2. I have achieved commercial success manufacturing and retailing the **SINGLE-SHEET REGISTRATION FORM AND KEY PACKET**, as

claimed in claims 1-7 and 11-15, since 2000. In the year 2000, my company sold 5,324,140 units for a total sales revenue of \$212,954. In the year 2001, my company sold 7,629,350 units for a total sales revenue of \$305,174. In the first five months of 2002, my company sold 5,071,429 units for a total sales revenue of \$177,500. My company sells the SINGLE-SHEET REGISTRATION FORM AND KEY PACKET, as claimed in claims 1-7 and 11-15, to many different hotel chains, including Hilton, Sheraton, Best Western, Crowne Plaza, and many independent hotels. Currently, my company's account base includes over 700 individual hotels. Since my SINGLE-SHEET REGISTRATION FORM AND KEY PACKET, as claimed in claims 1-7 and 11-15, is a new product, and since only relatively recently have two potential infringers begun to copy and market copied versions of my SINGLE-SHEET REGISTRATION FORM AND KEY PACKET, as claimed in claims 1-7 and 11-15, I feel that my SINGLE-SHEET REGISTRATION FORM AND KEY PACKET, as claimed in claims 1-7 and 11-15, currently enjoys about 99% of the current market. I am currently adding new hotels as customers at a rate greater than 1 per day.

3. After I had successfully commercialized my SINGLE-SHEET REGISTRATION FORM AND KEY PACKET, as claimed in claims 1-7 and 11-15, my SINGLE-SHEET REGISTRATION FORM AND KEY PACKET, as claimed in claims 1-7 and 11-15, has been copied, manufactured, and retailed by others, including USFI printers and Focus Services, without the "Patent Pending" notice and my company's identification. I have included two fax advertisements listing the copied SINGLE-SHEET REGISTRATION FORM AND KEY PACKET, as claimed in claims 1-7 and 11-15, for sale as Exhibit A.

4. In an email correspondence included as Exhibit B, an employee of Hilton Equipment Corporation, a subsidiary of the Hilton Hotels Corporation that provides hotel supplies to Hilton Hotels, attempted to force me to remove the "Patent Pending" notice and company identification from my SINGLE-

SHEET REGISTRATION FORM AND KEY PACKET, as claimed in claims 1-7 and 11-15, complaining that my **SINGLE-SHEET REGISTRATION FORM AND KEY PACKET**, as claimed in claims 1-7 and 11-15 has replaced the Hilton Welcome Key packet, a pre-printed form used prior to my invention of the **SINGLE-SHEET REGISTRATION FORM AND KEY PACKET**, as claimed in claims 1-7 and 11-15. I believe that Hilton Hotels Corporation took this step in order to position themselves to bid out production of **SINGLE-SHEET REGISTRATION FORM AND KEY PACKET**, as claimed in claims 1-7 and 11-15, to printers and vendors of pre-printed forms other than me. Hilton Hotels Corporation has recognized and substantially respected my patent pending status on my **SINGLE-SHEET REGISTRATION FORM AND KEY PACKET**. However, it is clear to me that, should I fail to acquire patent rights in my invention, and can no longer employ a patent-pending notice, my abilities to recoup significant development expenses through commercial exploitation of my invention will be severely and negatively impacted.

5. While living in Hilton Hotels three-to-four nights a week, from 1988 to 1992, I became keenly aware of excessive waste incurred through the use of check-in and check-out preprinted business forms. Two thirds of a two-ply form, an example of which is provided as Exhibit C, was discarded at check-in and one third discarded at check-out. The pre-printed, continuous forms were typically carbonless and processed by dot-matrix impact printers that were extremely noisy. Use of these forms required bursting, decollating, and the removal of line-hole stubs used to guide the forms through the dot-matrix printer. Alignment of the data with the form and jamming in the printer were two major problems encountered by users. Because I owned and managed a business-form manufacturing company for 25 years, the inefficiency was of interest to me.

The two-ply form used by Hilton Hotels was a combination Registration/Folio form designed as a standard for Hilton Hotels. In addition to this form, used at check-in, a key-packet folder was also used. The key

packet was typically pre-printed, die-cut, scored, and glued to create a pocket into which advertisements were inserted.

It occurred to me that a much less problem-prone, more efficient, and less expensive combine registration form and key packet could be devised to replace the above-described 2-ply Registration/Folio and separate key packet. I recognize that, with the advent of commercially practical laser printers in the 1990's, a laser-printer-based combined **SINGLE-SHEET REGISTRATION FORM AND KEY PACKET**, as claimed in claims 1-7 and 11-15, might provide a suitable alternative to the existing Registration/Folio and separate key packet, and through much experimentation and effort, succeeded in producing the **SINGLE-SHEET REGISTRATION FORM AND KEY PACKET**, as claimed in claims 1-7 and 11-15, in the summer of 1998, and began selling it to Hilton Hotels thereafter. Development of the **SINGLE-SHEET REGISTRATION FORM AND KEY PACKET**, as claimed in claims 1-7 and 11-15 involved development of an electronic-form template, development of the custom-die-cut **SINGLE-SHEET REGISTRATION FORM AND KEY PACKET**, as claimed in claims 1-7 and 11-15, integration with property management software, and programming of a flash-memory chip for laser printers. Examples of the **SINGLE-SHEET REGISTRATION FORM AND KEY PACKET**, as claimed in claims 1-7 and 11-15, including a blank **SINGLE-SHEET REGISTRATION FORM AND KEY PACKET**, with only minor pre-printing, as well as extensively pre-printed **SINGLE-SHEET REGISTRATION FORM AND KEY PACKET**, are included as Exhibit D.

My invention was thus born of personal observations of various check-in and check-out inefficiencies, extensive work with electronic forms, and the commercial availability of laser printers. Prior to my invention of the **SINGLE-SHEET REGISTRATION FORM AND KEY PACKET**, as claimed in claims 1-7 and 11-15, no similar product had been developed, and no similar product was in public use

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so

made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Ted Eugene Wright
Applicant

Date